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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/580,079	03/23/2007	John Joseph MacCarron	7733P010	8073

7590 06/09/2009  
BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP  
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LOS ANGELES, CA 90025-1026

EXAMINER
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LONG, ROBERT FRANKLIN

ART UNIT	PAPER NUMBER
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3764

MAIL DATE	DELIVERY MODE
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06/09/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/580,079	<b>Applicant(s)</b> MACCARRON, JOHN JOSEPH	
	<b>Examiner</b> Robert F. Long	<b>Art Unit</b> 3764	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 April 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☒ Claim(s) 6-18 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 04/06/09 has been entered.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**Claim 1** recites the limitation "the longitudinal or roll axis of the board" in line 5, and "respective rotation axes" in line 7. There is insufficient antecedent basis for this limitation in the claim. Examiner is interpreting the phrase to refer to simulator/board axis in line 4 to be the roll axis and the roll axis and "respective rotation axes" to be one singular "roll axis".

**Claim 4** recites the limitation "first simulator axis" in line 4. There is insufficient antecedent basis for this limitation in the claim. Examiner is interpreting the phrase refer to the roll axis and the respective rotation axes.

**Claim 6** recites the limitation "first simulator axis" in line 3 and "about mutually orthogonal pitch and yaw axes. There is insufficient antecedent basis for this limitation

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in the claim. Examiner is interpreting the phrase refer to the pitch and yaw axes of the foot binding axes.

**Claim 15** recites the limitation "the rider's seat" in line 13. There is insufficient antecedent basis for this limitation in the claim.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

**Claims 1-5** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Ziak (US 6705977)** in view of **Hersey (US 4826159)**.

**Regarding claims 1-5**, Ziak discloses board simulator comprising: a board/**platform 4**, a pivoting mount assembly/**ground contact member 8**, having a platform/**pivoting arrangement 6** to which foot bindings/**non slip pads 7** are coupled

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for a pivoting roll movement about a roll axis/**axis 10**, (abstract, column 2, lines 1-67, column 3, lines 1-14, figures 1-7).

Ziak fails to disclose a pair of slidably mounted foot bindings having an adjustment means for the foot bindings for movement toward and away from the other foot bindings in a direction substantially parallel to the first simulator axis,

Hershey discloses a similar board simulator device having a board/**balance board 18**, a pair of slidably mounted foot bindings/ **limiting device 25**, an adjustment means/**adjustable strap 60/62**, of the foot bindings for movement toward and away from the other foot bindings for a pivoting roll movement about a roll axis/**roller 16/roller axis**.

It would have been obvious to a person having ordinary skill in the art at the time of the invention to modify platform 4 of Ziak with sliding foot bindings in place of the non slip pads as taught by Hersey's adjustable straps 60/62/foot bindings and sliding limiting device 25 in order to have an more secure or additional foot attachment means and/or to have the desired longitude spacing of the feet for the desired pivoting exercise movement.

### ***Allowable Subject Matter***

**Claims 6-15** are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

**Claims 6-15** are objected to because of the antecedent basis 112 second paragraph errors but would be allowable if proper antecedent basis is recited. Appropriate correction is required.

**Claims 16-18** are allowed.

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-18 have been considered but are moot in view of the new ground(s) of rejection of newly cited art. Allowable subject matter has been noted in claims 6-15 per appropriate corrections.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure - **(US 20050148434 A1)** – *spring pivoting board*, **(US 5545115)** – *roll axis pivoting board* and **(US 6739974)** – *pivoting board interactive game simulator*.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert F. Long whose telephone number is (571)270-3864. The examiner can normally be reached on Monday-Friday (7:30-5).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, LoAn Thanh can be reached on (571) 272-4966. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Robert F Long/  
Examiner, Art Unit 3764  
Friday, June 05, 2009

/LoAn H. Thanh/  
Supervisory Patent Examiner, Art Unit 3764